

### **REMARKS**

In the Office Action<sup>1</sup>, the Examiner objected to the title of the specification; rejected claim 20 under 35 U.S.C. § 101 as allegedly directed toward non-statutory subject matter; rejected claims 1-3, 8-15, 19, and 20 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 5,845,143 to Yamauchi et al. ("*Yamauchi*"); rejected claims 1-3 and 8-15 under 35 U.S.C. § 102(e) as being allegedly anticipated by JP 08-101836; rejected claims 19 and 20 under 35 U.S.C. § 102(e) as being allegedly anticipated by JP 09-081572; and rejected claims 4-7, 16, and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 08-101836 in view of JP 09-081572. In the present Amendment, Applicant amends claims 1-5, 7, 8, 10-14, and 16-20.

#### **I. The Objection to the Specification**

The Examiner states that "the title of the invention is not descriptive" (Office Action at p. 2). Applicant has amended the title to "APPARATUS AND METHOD FOR SELECTING A TRANSLATION WORD OF AN ORIGINAL WORD BY USING A TARGET LANGUAGE DOCUMENT DATABASE" and submit that the amended title is descriptive of the claimed invention. Accordingly, Applicant respectfully requests the Examiner to withdraw the objection.

#### **II. The Rejection of Claim 20 Under 35 U.S.C. § 101**

The Examiner states, "[c]laim 20 ... is directed to non-statutory subject matter. The computer program product should be embodied in a computer readable medium"

---

<sup>1</sup> The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

(Office Action at p. 2). Amended claim 20 recites “a computer readable medium storing program codes for causing a computer to translate an original language to a target language” and, therefore, recites statutory subject matter. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claim 20 under 35 U.S.C. § 101.

**III. The Rejection of Claims 1-3, 8-15, 19, and 20 under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the Examiner’s rejection of claims 1-3, 8-15, 19, and 20 as allegedly being anticipated by *Yamauchi*. *Yamauchi* fails to disclose each and every element of any of claims 1-3, 8-15, 19, and 20, as required to sustain a rejection under 35 U.S.C. § 102(e). For example, *Yamauchi* at least fails to teach at least a “database control unit configured to ... assign a priority to each of the plurality of target language document databases according to a number of times the non-applied word appears in each of the target language document databases,” as recited in claim 1.

*Yamauchi* discloses a “language conversion system [that] converts an original sentence in a source-language into a translated sentence in a target language” (*Yamauchi*, col. 4, lines 61-63). *Yamauchi* also discloses that the system includes a “translation editor 7 includ[ing] a ... translation knowledge database” (*Yamauchi*, col. 10, lines 57-61). However, *Yamauchi* does not disclose assigning a priority to one or more translation knowledge databases. Moreover, *Yamauchi* does not disclose assigning such a priority according to a number of times a non-applied word appears in such a database. *Yamauchi*, therefore, fails to teach or suggest the claimed “database control unit configured to ... assign a priority to each of the plurality of target language

document databases according to a number of times the non-applied word appears in each of the target language document databases,” as recited in claim 1.

Claim 1 also recites “a translation word learning unit configured to select one of the plurality of translation word candidates as the translation word, by using the target language document database indicated by said database control unit” (emphasis added). As discussed, *Yamauchi* does not teach or suggest prioritizing the translation knowledge databases. Therefore, *Yamauchi* fails to teach or suggest the claimed “translation word learning unit configured to select one of the plurality of translation word candidates as the translation word, by using the target language document database indicated by said database control unit,” as recited in claim 1 (emphasis added).

Amended claim 1 is, therefore, allowable over *Yamauchi* for at least the same reasons. Claims 2, 3, and 8-15 are allowable at least due to their dependence from claim 1.

Claims 19 and 20, while of different scope, recite features similar to those recited in claim 1. Claims 19 and 20, therefore, are allowable at least for reasons discussed above in regard to claim 1.

Accordingly, Applicants request that the Examiner withdraw the rejection of claims 1-3, 8-15, 19, and 20 under 35 U.S.C. § 102(e) and allow the claims.

#### **IV. The Rejection of Claims 1-3 and 8-15 under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the Examiner’s rejection of claims 1-3 and 8-15 as allegedly being anticipated by JP 08-101836. JP 08-101836 fails to disclose each and every element of any of claims 1-3 and 8-15 as required to sustain a rejection under 35 U.S.C. § 102(e). For example, JP 08-101836 at least fails to teach the claimed

“database control unit configured to ... assign a priority to each of the plurality of target language document databases according to a number of times the non-applied word appears in each of the target language document databases,” as recited in claim 1.

JP 08-101836 discloses a “learning method for machine translation” where a “user checks the translation about whether proper equivalents are used” (JP 08-101836, English abstract). However, JP 08-101836 does not appear to disclose assigning a priority to a database according to the number of times a non-applied word appears in the database. JP 08-101836, therefore, fails to teach or suggest the claimed “database control unit configured to ... assign a priority to each of the plurality of target language document databases according to the number of times the non-applied word appears in each of the target language document databases,” as recited in claim 1.

Claim 1 is, therefore, allowable over JP 08-101836 and claims 2, 3, and 8-15 are allowable at least due to their dependence from claim 1. Accordingly, Applicant requests that the Examiner withdraw the rejection of claims 1-3 and under 35 U.S.C. § 102(e) and allow the claims.

**V. The Rejection of Claims 19 and 20 under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the Examiner’s rejection of claims 19 and 20 as allegedly being anticipated by JP 09-081572. JP 09-081572 fails to disclose each and every element of any of claims 19 and 20 as required to sustain a rejection under 35 U.S.C. § 102(e). For example, JP 09-081572 at least fails to teach the claimed “assigning a priority degree to each of the plurality of target language document databases according to a number of the non-applied word of translation word’s selection,” as recited in claim 19.

JP 09-081572 discloses a “translation device and dictionary priority setting method” (JP 09-081572, English abstract). The method includes increasing the priority of dictionaries from which words are frequently selected. However, JP 09-081572 does not appear to disclose assigning a priority to a database according to the number of times a non-applied word appears in the database. JP 09-081572, therefore, fails to teach or suggest the claimed “assigning a priority degree to each of the plurality of target language document databases according to a number of the non-applied word of translation word’s selection,” as recited in claim 19.

Claim 19 is, therefore, allowable over JP 09-081572. Claim 20, while of different scope, recite features similar to those recited in claim 19. Claims 20, therefore, is allowable at least for reasons discussed above in regard to claim 19. Accordingly, Applicant requests that the Examiner withdraw the rejection of claims 19 and 20 under 35 U.S.C. § 102(e) and allow the claims.

**VI. The Rejection of Claims 4-7, 16, and 17 under 35 U.S.C. § 103(a)**

Applicant respectfully traverse the rejection of claims 4-7, 16, and 17 under 35 U.S.C. § 103(a). Claims 4-7, 16, and 17 depend from claim 1, and each require all of the subject matter recited in their respective base claim. As discussed above with respect to claims 1 and 19, neither JP 08-101836 nor JP 09-081572 teaches or suggests at least “assigning a priority degree to each of the plurality of target language document databases according to a number of the non-applied word of translation word’s selection.”

For at least the reason that the cited references, taken alone or in combination, fail to teach or suggest each and every claim element required by claims 4-7, 16, and

17 due to their dependence from claim 1, no *prima facie* case has been established with respect to these claims. Therefore, Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 4-7, 16, and 17.

**VII. Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 2, 2007

By: Richard V. Burgujian Reg. No. 53,232  
For Reg. No. 31,744